



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/078,768	06/16/1993	RICHARD H. TULLIS	PMB9658	9155
32650	7590	09/15/2004	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE - 46TH FLOOR PHILADELPHIA, PA 19103			MARTINELL, JAMES	
			ART UNIT	PAPER NUMBER

1631

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address : COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

EXAMINER


ART UNIT	PAPER
----------	-------

091004

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents


James Martinell
Primary Examiner
Art Unit: 1631
9/10/04

Art Unit: 1631

The appeal brief filed July 8, 2004 is defective in that it refers to patents that are not of record.

The patents referred to that are not of record are:

- (a) U.S. Patent No. 4,689,320;
- (b) U.S. Patent No. 5,264,423;
- (c) U.S. Patent No. 5,276,019;
- (d) U.S. Patent No. 5,442,049; and
- (e) U.S. Patent No. 5,595,978.

These patents are referred to indirectly in the brief filed July 8, 2004 in the paragraph bridging pages 16-17. The brief states, "The patents covering fomivirsen (which may be found at <http://www.fda.gov/cder/ob/default.htm>) relate to compositions and methods for inhibiting propagation of a virus by employing an oligonucleotide hybridizable to a mRNA of the virus." The brief then goes on to further discuss these patents. Since these patents are not of record, citation (however indirect) of them and discussion of their contents for the first time is improper at this stage of prosecution. Entry of new evidence in an application on appeal is not a matter of right (MPEP 1207) and must be submitted as a paper separate from the appeal brief. In addition, any amendment, affidavit, or other new evidence on appeal is governed by 37 CFR §§ 1.116 and 1.195 (MPEP 1207). Since none of these conditions has been complied with, the appeal brief is defective.

Appellant's assertion (paper filed July 8, 2004 accompanying the brief, page 2, last full paragraph) that, "Appellant has removed reference thereto [the U.S. Patents listed hereinabove] in the accompanying Appeal Brief" is most unconvincing.

Appellant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719. The fax phone number for Examiner Martinell's desktop workstation is (571) 273-0719. The examiner works a flexible schedule and

Art Unit: 1631

can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-0722.


PLEASE NOTE THE NEW FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.


James Martinell, Ph.D.
Primary Examiner
Art Unit 1631

9/10/04